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| 44367 7590 02/12/2009<br>SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402-0938 |             |                      |                     |                  |
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| GARG, YOGESH C   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/903,457

**Applicant(s)**

JOSEPH ET AL.

**Examiner**

Yogesh C. Garg

**Art Unit**

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 165-167, 185, 218-220, 236, 252 and 256-261 is/are pending in the application.
- 4a) Of the above claim(s) 168-185, 221-235, 247 and 250 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 165-167, 185, 218-220, 236, 252 and 256-261 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/10/08&12/9/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's amendment filed 12/9/2008 is entered. Claims 1-164, 186-217, 237-246, 248-249, 251, 253-255 are cancelled, claims 168-185, 221-235, 247, 250, are previously withdrawn. Claims 165, 167, 168, 175, 176, 178, 182-185, 218-230, 233-236, 247, 250, 252 are currently amended and new claims 256-261 are added. Claims 165-167, 185, 218-220, 236, 252, and 256-261 are currently pending for examination. This application is a divisional application of a copending reissue application 09672,523 filed 9/27/2000.

This is a non-final rejection.

### ***Claim Rejections - 35 USC § 251***

2.1 Claims 165-167, 185, 218-220, 236, 252, and 256-261 are rejected as being based upon a defective reissue Declaration filed 7/10/2001 under 35 U.S.C. 251 as set forth below. See 37 CFR 1.175.

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The stated error relied in the in the declaration to support the reissue application is that the additional claims belonging to other embodiments "could have been claimed " as recited in the reissue application, which is amounting to claiming "less than" patentee had a right to claim. The stated error does not render the original claims of the patent wholly or partly inoperative or invalid in accordance with USC 251. The original claims, as patented, stand on their own without requiring the limitations of the new claims belonging to a different embodiment. See MPEP 1402 (*...All claims pending in a reissue application in which (1) the reissue applicant presents one or more claims that are all narrower than the broadest patent claims(s), and (2) the only error that is alleged to support the reissue is that the additional claims "could have been claimed" or that the patentee was claiming "less than" patentee had a right to claim ("less than" being used to mean "too few" claims), are to be rejected as failing to state an error under 35 U.S.C. 251. The rejection must be maintained unless (1) the reissue application is thereafter amended to include a reissue oath/declaration that specifies a different "error," i.e., an error that renders the patent wholly or partly inoperative or invalid in accordance with 35 U.S.C. 251, and (2) includes a corresponding correction of that 35 U.S.C. 251 error. ....* ). The filed declaration does not identify the existence of an error in the specification, drawings, or claims, which causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon. **In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.** The filed declaration does not do this. Instead it merely states that the original claims did not cover certain embodiments. **This statement of error is not sufficient because it does not identify a single word, phrase, or expression in the**

**specification or in an original claim (s) 1-9, and how it renders the original patent wholly or partly inoperative or invalid.** The statement filed is no better than saying in the reissue declaration that this "application is being filed to correct errors in the patent which may be noted from the change made by adding new claim s", see MPEP 1414, II, C.

2.2.. Claims 165-167, 185, 218-220, 236, 252, and 256-261 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The "recapture rule," prevents a patentee from regaining, through a reissue patent, subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

*Clement* discusses a three-step test for analyzing recapture:

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim.

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

- (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;
- (b) if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

The Federal Circuit in *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d at 1350, 75 USPQ2d 1545 (Fed. Cir. 2005) further refined Substep (3) (a) of *Clement* to define "broader in an aspect germane to a prior art rejection" to mean broader with respect to a specific limitation

- (1) added to overcome prior art in prosecution of the application which matured into the patent sought to be reissued and
- (2) eliminated in the reissue application claims.

"Surrendered subject matter" is defined in connection with prosecution history estoppel in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 733-34, 122 S. Ct. 1831, 1838, 62 USPQ2d 1705, 1710-11 (2002). A patentee's decision to narrow his claims through amendment "may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Exhibit Supply*, 315 U.S., at 136-137, 62 S. Ct. 513. "...in determining whether 'surrender' of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent." *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323, 80 USPQ2d 1495, 1502 (Fed. Cir. 2006).

A further opinion, *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003), issued by the Board of Appeals and Interferences as a precedential opinion, is also part of the recapture precedent applicable to proceedings before the United States Patent & Trademark Office (USPTO). *Eggert* was entered on May 29, 2003, prior to the Federal Circuit's *North American Container* decision. In *Eggert* the majority held that the surrendered subject matter was the rejected claim **only** rather than the amended portion of the issued claim.

A published precedential opinion of the Board is binding unless the views expressed in an opinion in support of the decision, among a number of things, are inconsistent with a decision of the Federal Circuit. In this case, the majority view in *Eggert* is believed to be inconsistent with the subsequent Federal Circuit decision in *North American Container* with respect to the principles governing application of Substep (3)(a) of *Clement*. See: *Ex parte Franklin C. Bradshaw and Thomas L. Soderman*, (Appeal 2006-2744 Bd. Pat. App. & Int. July 19, 2007) (available in Application 09/664,794 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd062744.pdf>); *Ex parte Raanan Liebermann*, (Appeal 2007-0012 Bd. Pat. App. & Int. May 2007) (available in Application 09/603,247 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd070012.pdf> ); *Ex parte Willibald Kraus* (Appeal 2005-0841 Bd. Pat. App. & Int. April 2005) (available in Application 08/230,083 and at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd050841.pdf> )

As set forth in the above BPAI decisions, based on *North American Container* and other court decisions, surrendered subject matter is considered the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scopes of

- (a) the application claim which was canceled or amended and
- (b) the patent claim which was ultimately issued.

Accordingly, the "surrendered subject matter" that may not be recaptured through reissue should *be presumed* to include subject matter broader than the patent claims in a manner directly related to

- (1) limitations added to the claims by amendment (either by amending an existing claim or canceling a claim and replacing it with a new claim with that limitation) to overcome a patentability rejection and
- (2) limitations argued to overcome a patentability rejection without amendment of a claim.

However, when reissue claims are narrower than the patent claims with respect to features other than the surrender generating feature, then the reissue claims may be materially narrowed relative to the claims prosecuted and issued in the patent, thereby avoiding the recapture rule.

As explained in *Hester Industries, Inc. v Stein, Inc.*, 142 F.3d 1472, 1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998), the recapture rule is avoided when two conditions are satisfied. First, an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution. Second, the reissue claim must have been materially narrowed with respect to this overlooked aspect of the invention.

In summary, the recapture rule is avoided if the reissue claim was materially narrowed in other respects compared to its broadening surrendered aspect. A reissue claim is materially narrowed and thus avoids the recapture rule when limited to aspects of the invention:

- (1) which had not been claimed and thus were overlooked during prosecution of the original patent application; and
- (2) which patentably distinguish over the prior art.

In the instant case, the reissue claims satisfy the "recapture rule" preventing a patentee from receiving a reissue patent as per both *Clement three steps test* and

*Hester Industries, Inc, v Stein, Inc., 142 F.3d 1472,1480, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998)* as analyzed below:

A: Analysis per *Clement three-step test*:

New claims 165-167, 185, 218-220, 236, 252, and 256-261 are broader than the patented claims 1-9 because they do not include limitations recited in the patented claims 1-9. There was a surrender of subject matter in the original application prosecution and the broadening of the reissue claims is in the area of the surrendered subject matter. The omitted/broadened limitations in the reissue claims are directed to limitations relied upon by the applicant in the original application to make the claims allowable over prior art (At a minimum, the claims require at least one of the following limitations which were argued as the patentable feature for the issued independent claims 1, 6, 7, and 9 in the 08/233,908 application: *a source of a data stream providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted OR a client computer, which includes a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and directing packets containing said associated distributed computing application to a further processor OR further processor including means to assemble said distributed computing application and execute said distributed computing application to form an*



*interactive video program in which execution of said distributed computing application alters said video program OR a source of a time division multiplexed packet signal including a plurality of distributed computing applications, each distributed computing application being repetitively transmitted independent of receiving client computer apparatus, and each of said distributed computing applications being in a form of a series of packets OR a first one of packets of a respective series containing data representing an executable code module and including identification information indicating that the first one of packets of said series contains data representing said executable code module OR the client computer extracts said directory module from the data stream and using data contained in the directory module extracts packets associated with said distributed computing application and builds said distributed computing application and executes said distributed computing application OR read/write memory, coupled to the system bus; a data stream input/output adapter, coupled between the data stream receiver and the system bus, for receiving the extracted distributed computing application representative data from the data stream receiver, and storing it in the read/write memory, and having a control output terminal coupled to the selection control input terminal of the data stream selector, for producing the selection control signal; and a processor, coupled to the system bus, for controlling the data stream input/output device to generate a selection control signal selecting a specified one of the plurality of data streams, and for assembling and executing the distributed computing application stored in the read/write memory.).* The filed re-issue claims are broader than the original patent claims by not including the surrender-generating limitations (as described above) will be barred by the recapture rule even though there is narrowing of the claims not related to the surrender-generating limitation. As stated in the decision of *In re Clement*, 131 F.3d at

1470, 45 USPQ2d at 1165, if the reissue claim is broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim. *Pannu v. Storz Instruments Inc.*, *supra*, then brings home the point by providing an actual fact situation in which this scenario was held to be recapture.

B: Analysis as per *Hester Industries, Inc. v Stein, Inc.*: In order to satisfy the two conditions, the subject matter that materially narrows the reissue claims should be the overlooked aspect of the original invention claimed in the patent. In the instant case, the reissue claims do not include any subject matter of the patented claims (independent patented claims 1, 6, 9, 10) but instead the subject matter that materially narrows the reissue claims is directed to a distinct and different invention and it is not the overlooked aspect of the original invention.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 185 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. Claim 185, dependent of claim 165, recites receiving an order at the client system from a server system whereas claim 165 recites that it is the client system which sends the order to the server and therefore renders claim 185 unclear. As best understood by the examiner the client system receives an order confirmation from the server in response to the order send by the client system to the server.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 165-167, 185, 218-220, 236 and 252 165-167, 185, 218-220, 236, 252, and 256-261 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No.

5,621,456, Florin et al (hereinafter Florin) in view of Garneau et al. (US Patent 5,497,420), hereinafter, Garneau.

Regarding claim 165, Florin discloses a method of facilitating ordering an item using a distributed computing system including at least one client and at least one server, the method comprising (i.e. home shopping interface)(see Fig. 1, and col. 23, line 59 - col. 24, line 7):

receiving an order request at a client system, automatically determining an item identity for an item to which the order request pertains, automatically retrieving personal information previously stored the retrieved personal information pertaining to a user associated with the client system and causing an order to be placed, the order including the item identity and the retrieved personal information (see col.24, lines 7-58 and Figs. 45-50 discloses receiving an order request via icon 409 at a client system, automatically determining an item identity for an item , such as " Lucks Mini Espresso" to with the order request pertains and causing an order to be placed[see figs 49-50] including the item identity and the retrieved personal information relating to the PIN entered in Fig.49. The inputting of PIN causes automatically retrieving personal information previously stored the retrieved personal information pertaining to a user associated with the client system for making payments, see col.12, line 63-col.13, line 6 and col.22, lines 32-41).

Florin does not explicitly disclose that retrieved personal information is previously stored in a permanent memory of the client system. However, Garneau teaches this limitation, see at least col.2, lines 25-37. Garneau teaches automatically retrieving a

physical address of the subscriber terminal previously stored to enable placement of an order for a pay-per-view event. In view of Garneau, it would be obvious to one of an ordinary skilled in the art to incorporate the feature of Garneau because it would help the Flynn process to coordinate the billing and conclusion of the order by identifying the buyer and billing it to him the order charges.

Regarding claim 166, Florin teaches that the order request is received at the client system through detection of an order action by the user utilizing the client system (see figs. 49 & 50 where the user uses order icon on the client system which triggers placement of order).

Regarding claim 167, Florin teaches that the order action is performed during the showing and/or describing of the item via the client system (i.e. full motion video display of various paid for commercials or advertising messages)(see Fig. 44-50 and col. 23, line 67 - col. 24, line 7);

Regarding claim 185, florin teaches receiving, at the client system from a server system, an order confirmation (see at least Fig.50).

Regarding claims 218-220, 236, 252 and 256-261, their limitations are closely parallel to the limitations of claims 165-167 and 185 and therefore they are analyzed and rejected on the basis of same rationale as set forth for claims 165-167 and 185

above. With reference to claims 256-261, Garneau teaches that the interactive client system in Florin can be replaced by an interactive television system in the form of a subscriber terminal (see Fig.1 in Garneau) and this television system that is the subscriber terminal can correspond to a set-top box including a receiver (see Fig.1 in Garneau, "37—Data receiver").

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 165-167, 185, 218-220, 236 and 252 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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